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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,298	02/17/2004	Leo J. Romanczyk JR.	1010/101US14	9721
32260	7590	09/12/2005	EXAMINER	
NADA JAIN, P.C. 560 White Plains Road, Suite 460 Tarrytown, NY 10591			SOLOLA, TAOFIQ A	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/780,298

Applicant(s)

ROMANCZYK ET AL.

Examiner

Taofiq A. Solola

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 09 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 34-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 34-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Claims 34-73 is pending in this application.

Double Patenting Rejection

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 34-73 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 209-230 of allowed Application No. 10/127,817. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

In both cases, the claims are drawn to methods of using the same compound for treating atherosclerosis, thrombosis, heart attack, stroke or vascular circulation problem (in 10/127,817), and for anti-platelet therapy in the instant application. However, according to the specification, page 10, lines 31-32, platelet aggregation is involved in the progression of atherosclerosis. Also, on page 14, lines 32-35, the specification discloses that aggregation of platelets leads to thrombus formation (thrombosis), which is responsible for "acute myocardial infarction, unstable angina and percutaneous coronary intervention", and "anti-platelet therapy decrease[s] the incidence of primary and secondary coronary events." Therefore, the claims in the instant application and 10/127,817, are drawn to the same subject matter.

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Claims 34-73 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 209-224 of allowed Application No. 10/770,969. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

In 10/770,969, the claims are drawn to methods of using epicatechin and/or catechin for treating atherosclerosis, thrombosis, heart attack, stroke or vascular circulation problem. In the instant application, the claims are drawn to method of using procyanidin for anti-platelet therapy. However, according to the specification, page 2, lines 20-22, "procyanidin [is] selected from epicatechin, catechin, procyanidin B-2, procyanidin oligomers 2-12, preferably 2-14 or 4-12, more preferably 3-12 and most preferably 5-12, procyanidin B-5, procyanidin A-2 and procyanidin C-1." On page 10, lines 31-32, the specification further states that platelet aggregation is involved in the progression of atherosclerosis. Also, on page 14, lines 32-35, the specification discloses that aggregation of platelets leads to thrombus formation (thrombosis), which is responsible for "acute myocardial infarction, unstable angina and percutaneous coronary intervention", and "anti-platelet therapy decrease[s] the incidence of primary and secondary coronary events." Therefore, the claims in the instant application and 10/770,969, are drawn to the same subject matter.

Applicant's arguments filed 8/9/05 have been fully considered but they are not persuasive. Applicant filed a Terminal Disclaimer and contends that the subject being treated are not the same in the instant application vis-à-vis US '817 and US '969. This is not persuasive because applicant's contention is not supported by the specification. More importantly, the treated subject is not applicant's invention. Applicant's invention is the utility of the compound as described in the specification. Also, the term "human" embraces all "humans".

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD, whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

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TAOFIQ SOLOL
PRIMARY EXAMINER

Group 1626

September 2, 2005